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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/992,379

11/19/2001

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10547.20US2

5630

34018 7590 11/12/2008
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EXAMINER

BUCHANAN, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/992,379
Filing Date: November 19, 2001
Appellant(s): BORELLI ET AL.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 26, 2004 appealing from the Office action mailed March 19, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,182,054

DICKINSON et al.

1-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. alone.

With regard to claim 1, Dickinson discloses a method for provisioning services that includes receiving a user selection for one or more services available via the network (abstract, see Figs. 7-9, col. 4 line 30+, col. 5 line 45+, services are deemed available over a network, e.g., phone, cable tv), receiving registration information from the user including billing information and a user identifier (col. 3 line 22+, col. 4 line 40+,

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receiving information for service, subscriber, etc.), authenticating the user information (identifier) and communicating it to the service provider (col. 4 line 36+, subscriber data sent to provider, col. 5 line 50+, common practice and inherent that user data is sent to provider), communicating the user and service information to a billing engine (col. 3 line 21+, billing system receives customer and usage data, col. 5 line 46+, abstract), and billing the user for services used (abstract, col. 2 line 1+, col. 4 line 47+, col. 5 line 46+, col. 6 line 58+).

The method of Dickinson differs from the claimed invention in that it does not explicitly show the services provider to be an internet services provider (ISP). However, a variety of services could be provided to a user via a network without changing the nature or functioning of the invention and the particular service provided would be a matter of design choice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Dickenson so that the service provider is an internet service provider since the particular service provided is a matter of design choice.

With regard to claim 2, available services can be retrieved from a catalog (col. 4 line 47+, see Fig. 8). With regard to claims 3-5, broadband type access is well known (col. 5 line 1+) and it would be obvious to one skilled in the art to determine if any peripheral services or devices are needed in order to provide a service, since this is common practice and well known in the art (eg, cable box pay per view services).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. alone.

With regard to claim 6, Dickinson discloses a system for aggregating services from multiple providers and providing the services to end users (col. 2 line 1+, see Figs. 1-5, system can handle multiple plans, services, etc.) that includes a catalog of available services available to users having rate and payment information (col. 2 line 43+, col. 4 line 47+, col. 5 line 30+, see Fig. 8, system stores rating data for various plans, i.e., catalog), a rating engine for processing service usage and reconciling payments (abstract, col. 4 line 47+, col. 5 line 46+, col. 6 line 58+), and a provisioning subsystem that allows services to be provided to the user and creates usage events for processing by the rating engine (col. 7 line 44+, see Figs. 7-9, inherent in the invention).

The system of Dickinson differs from the claimed invention in that it does not explicitly show the provisioning subsystem to allow the provider to register purchase offerings. However, the provisioning subsystem would be able to store and process a variety of data, including offerings, purchases, returns, etc., and the particular data stored would be a matter of design choice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Dickinson to store and process purchase offerings data since this would be a matter of design choice.

With regard to claims 7 and 8, the system has a standardized interface (see Figs. 7-9, col. 6 line 59+) and an IP address rules server to provide user access to services (col. 4 line 66+).

Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. alone.

With regard to claims 9 and 10, Dickinson discloses a computer readable media having instructions and a method for provisioning services that includes receiving a user selection for one or more services available via the network (abstract, see Figs. 7-9, col. 5 line 45+), receiving registration information from the user including billing information and a user identifier (col. 3 line 22+, col. 4 line 40+), authenticating the user information and communicating it to the service provider (col. 4 line 36+, subscriber data sent to provider, col. 5 line 50+, common practice and inherent that user data is sent to provider), communicating the user and service information to a billing engine (col. 5 line 46+, abstract), and billing the user for services used (abstract, col. 2 line 1+, col. 4 line 47+, col. 5 line 46+, col. 6 line 58+).

The method of Dickinson differs from the claimed invention in that it does not explicitly show the services provider to be an internet services provider (ISP) or the service to be broadband. However, a variety of services could be provided to a user via a network without changing the nature or functioning of the invention and the particular service provided would be a matter of design choice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Dickenson so that the service provider is an internet service provider and the service is broadband since the particular service provided is a matter of design choice. Broadband type access is well known and it would be obvious to one skilled in the art to determine if any peripheral services or devices are needed in order to provide a service, since this is common practice and well known in the art (e.g., cable box for pay per view services).

With regard to claims 11-14, query messages can be received by an ISP website, a provider order entry system, a customer service rep (col. 2 line 1+, col. 5 line 30+, common practice), and could include a variety of information, such as user system details. With regard to claims 14-17, it is well known and common practice for service providers to determine system capabilities and to prioritize users. With regard to claims 18 and 19, the catalog includes rating guidelines and an IP address rules server is used to provide user access to services (col. 4 line 66+).

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. alone.

Dickinson discloses a computer readable media having instructions and a method for provisioning services that includes receiving a user selection for one or more services available via the network (abstract, see Figs. 7-9, col. 5 line 45+), receiving registration information from the user including billing information and a user identifier (i.e., universal customer identifier (name for example), col. 3 line 22+, col. 4 line 40+)

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associated with a billing engine (subscriber data is synchronized for various services to create a single bill), authenticating the user information and communicating it to the service provider (col. 4 line 36+, subscriber data sent to provider, col. 5 line 50+, common practice and inherent that user data is sent to provider), communicating the user and service information to a billing engine (col. 5 line 46+, abstract), and billing the user for services used (abstract, col. 2 line 1+, col. 4 line 47+, col. 5 line 46+, col. 6 line 58+).

The method of Dickinson differs from the claimed invention in that it does not explicitly show the service to be broadband. However, a variety of services could be provided to a user via a network without changing the nature or functioning of the invention and the particular service provided would be a matter of design choice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Dickenson so that the service is broadband since the particular service provided is a matter of design choice. Broadband type access is well known and it would be obvious to one skilled in the art to determine if any peripheral services or devices are needed in order to provide a service, since this is common practice and well known in the art (e.g., cable box for pay per view services).

(10) Response to Argument

Appellant's arguments have been fully considered but they are not persuasive. Appellant argues repeatedly that the rejection has failed to establish where and how the

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Dickinson reference discloses each and every element of the claims considering each and every word.

The examiner disagrees and stands by the rejection. In the examiner's view, the elements of the claims are explicitly disclosed by Dickinson, matters of design choice, common knowledge, or inherent in the reference, as set forth in the rejection above, which has been clarified to address appellant's remarks. For example, appellant argues that it has not been established where Dickinson discloses "receiving a user selection of one or more services that have been deemed to be available to the user via the network." In the rejection above, the examiner refers to Figs. 7-9 and the text of the reference (col. 4 line 30+, col. 5 line 45+) for these elements, which show a variety of available services displayed to a user via a graphical interface, thus disclosing one or more services that have been deemed to be available to the user via the network. Appellant appears to be requesting a word for word matching of the prior art disclosure to the recited features of the claimed invention. This, however, would be near impossible due to differences in terminology used, time constraints imposed on the examiner, and actual differences between the prior art and claimed invention. Furthermore, the rejection is being made under U.S.C. 103, not U.S.C. 102, and does not require an identical match between the prior art and the claimed invention. Much of the rejection relies upon the examiner's interpretation of what features are being claimed and what is being disclosed by the prior art, and the examiner has elaborated on this issue in the rejection to clarify his interpretation of various matters.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Christopher R Buchanan/

Examiner, Art Unit 3627

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Vincent Millin /VM/
Appeals Conference Specialist- TC 3600